

ESTTA Tracking number: **ESTTA331583**

Filing date: **02/11/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91176791
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Date	02/11/2010
Attachments	Applicant's Opening Trial Brief.pdf (55 pages)(1277489 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/751,105
Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.

Applicant

OPENING TRIAL BRIEF OF APPLICANT MATTEL, INC.

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I. INTRODUCTION

Applicant Mattel, Inc. (“Applicant”) makes and sells toys, including the famous HOT WHEELS brand of toy vehicles. In 2006 and 2007, Applicant produced a series of seven HOT WHEELS toy cars that were replicas of classic “muscle cars” manufactured in the late 1960s and early 1970s by the “Big Three” American automobile manufacturers located in Detroit, Michigan. These toy cars were sold with packaging bearing the mark MOTOWN METAL to convey the famous muscle cars’ association with Detroit.

The questions before the Board in this Opposition are (1) whether a reasonably prudent purchaser is likely to be confused that Applicant’s HOT WHEELS toy cars bearing the MOTOWN METAL mark originate from, are associated with, or are endorsed by Opposer UMG Recordings, Inc. (“Opposer”); and (2) whether Applicant’s use of MOTOWN METAL will dilute Opposer’s MOTOWN mark. The answer to both questions is a resounding “no.”

Viewed, as they must, in the context of their actual uses, the absence of a likelihood of confusion is manifest. Applicant used its mark in connection with seven HOT WHEELS toy cars. Opposer uses its mark in connection with recorded music and music-related products, not in connection with toys or toy vehicles. Nevertheless, Opposer is trying to claim exclusive rights in the word *Motown* across all classes and categories. As demonstrated herein, *Motown* has been commonly used in commerce for decades to **describe** the geographic location of Detroit, Michigan.¹ It follows that if Opposer is successful here in its quest to monopolize the use of the word *Motown*, third parties like Applicant will be unable to fairly and accurately convey to buyers that their products or services originate from or are associated with Detroit.

¹ As will also be seen, in addition to its geographic descriptiveness, the word *Motown* has come to commonly describe a style or genre of music, the “Motown sound.” Now the equivalent to musical styles such as “jazz,” “rock,” and “rhythm and blues,” the mark MOTOWN has arguably become generic when applied to music and thus is entitled to no trademark protection at all.

Opposer cannot “impoverish the language of commerce” (*Bada Co. v. Montgomery Ward & Co.*, 425 F.2d 8, 11 (9th Cir. 1970)) by claiming exclusive rights to *Motown* for the simple reason that the word has several meanings. ***First and foremost***, it means the city of Detroit, Michigan. From standard dictionary definitions, to references to the government’s recent financial bailout of the American automobile industry as the “Motown Bailout,” to last year’s “Road to Motown” NCAA Men’s Basketball Tournament (the “Final Four” of which took place in Detroit), Applicant’s evidence for this pervasive use is overwhelming and indisputable.

Second, *Motown* means a genre of popular music—*i.e.*, “the Motown sound.” While it may be true that artists originally associated with the Motown record label (along with others) initially popularized this sound, today the “Motown sound” has taken on such a life of its own that it has exceeded Opposer’s grasp. Indeed, recording artists who never recorded a note for the Motown record label, including such iconic performers as Aretha Franklin and Tina Turner, are commonly referred to as “Motown artists” who record and perform “Motown music.”

Lastly, *Motown* means the Motown record label founded in Detroit in 1959 and currently owned by Opposer. But even the founder of Motown Records, legendary music executive Berry Gordy, Jr., admits in his autobiography that, in naming his record company, he intended to conjure up the image of his native Detroit, seeking a word

that would capture the feeling of my roots—my hometown.
Because of its thriving car industry, Detroit has long been known
as the “Motor City.”.... I used “town” in place of “city.” A
contraction of “Motor Town” gave me the perfect name—Motown.

(Trial Declaration of Peter Caparis submitted by Opposer (“Caparis Decl.”), Ex. 2.) Applicant could not have said it better itself; Opposer’s MOTOWN mark sprang to life directly out of its association—in its creator’s own mind—with Detroit. It is therefore disingenuous, and contrary

to the evidence and to common sense, for Opposer to maintain that every use of the word *Motown* conjures up only the image of Opposer in the consuming public's mind.

Applicant's use of *Motown* is precisely one such use that does not conjure an image of Opposer's record label, or even of music at all. Applicant uses *Motown* as part of its mark to convey to the purchasers of its die-cast toy cars the most common connotations of the word: Detroit and the American automobile industry. Because of the nature of Applicant's use of *Motown*, Opposer has no valid grounds on which to oppose registration of MOTOWN METAL.

Opposer's MOTOWN mark is merely descriptive, both geographically and of a genre of music. It thus requires secondary meaning in order to have any trademark significance. Assuming for the sake of argument that Opposer's mark has secondary meaning when applied to music-related products, it has *none* when applied to toys or toy vehicles. "Some cases decide a trademark conflict for the junior user by saying that while plaintiff's mark is strong in its own market, it is weak in defendant-junior user's market." J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2009), § 11:77 (hereafter "McCarthy"). That is precisely the case here. While Opposer's mark might be strong as to music recordings, it is unquestionably weak as to toys and has no secondary meaning in the toy market.

In addition, even assuming that Opposer's mark is distinctive (which Applicant does not concede), there is absolutely no likelihood of confusion between it and Applicant's MOTOWN METAL mark. Opposer pays little attention in its brief to its *affirmative burden* of *proving* a likelihood of confusion, focusing instead on a preemptive attempt to rebut Applicant's arguments that MOTOWN is descriptive. Yet, the relevant factors clearly demonstrate that there is no likelihood of confusion between the marks. The marks are too dissimilar in appearance, sound, connotation, and commercial impression to be likely to be confused; the parties' relevant goods

and trade channels are too dissimilar to cause a likelihood of confusion; the conditions under which buyers purchase the parties' products, and the sheer number of marks in use using the word *Motown*, show that there is no likelihood of confusion. Put another way, while Opposer's MOTOWN mark may have certain strength in the music business, it is demonstrably weak outside of music. Nor has Opposer presented *any* evidence of any actual confusion.

Finally, there is even less likelihood that Applicant's use of MOTOWN METAL will dilute Opposer's mark. Because the MOTOWN mark only enjoys "niche" fame in the music market (*see UMG Recordings, Inc. v. O'Rourke*, 92 U.S.P.Q.2d 1042 (T.T.A.B. 2009) ("Opposer's [MOTOWN] mark is famous for musical recordings and performances")), and because the two marks are sufficiently different, Applicant's MOTOWN METAL mark cannot and will not dilute Opposer's mark. Additionally, in a dilution analysis all doubts must be resolved in favor of Applicant, not Opposer. Opposer's dilution claim is simply a gratuitous "add-on" to its Opposition and is readily dismissed.

II. STATEMENT OF ISSUES

The issues before the Board are:

1. Whether a reasonably prudent purchaser is likely to be confused that Applicant's HOT WHEELS toy cars bearing the MOTOWN METAL mark originate from, are associated with, or are endorsed by Opposer (Lanham Act Section 2(d), 15 U.S.C. § 1052(d));
2. Whether Applicant's use of MOTOWN METAL will dilute Opposer's mark (Lanham Act Section 43(c), 15 U.S.C. § 1125(c)); and
3. Whether, to the extent that Opposer seeks registrations for its mark in International Class 28, a finding of likelihood of confusion between Applicant's MOTOWN METAL mark and Opposer's mark will be avoided by limiting, restricting, and/or cancelling

Opposer's mark to preclude its registration or use in connection with toy vehicles or accessories therefor (Lanham Act Section 18, 15 U.S.C. §1068).

III. DESCRIPTION OF THE RECORD

Opposer's description of the parties' stipulations and submitted evidence is accurate, with the caveat that, regarding evidence submitted pursuant to the parties' stipulations, each party reserves the right to object to any evidence submitted against it on any applicable ground.

IV. STATEMENT OF FACTS

A. Applicant's Business

Applicant Mattel, Inc. is the world's largest manufacturer, distributor, and marketer of toys and accessories therefor. Among its numerous famous brands, Applicant is the owner of the internationally famous HOT WHEELS brand of toy cars and accessories. In addition, among its many registered trademarks, Applicant owns the registered trademarks to the HOT WHEELS mark and related graphics and logos.

Applicant began using the trademark HOT WHEELS in 1967, and the first die-cast toy cars bearing the HOT WHEELS mark were sold in the U.S. in 1968. HOT WHEELS were an instant success and are one of the most popular and successful toys in history. Since their inception, it is estimated that Applicant has produced over 4 billion HOT WHEELS toy cars. HOT WHEELS enjoy approximately \$1 billion a year in global sales. (*See Applicant's supplemental Notice of Reliance re: Printed Publications, Vol. 1, Ex. A, pp. 11-15.*) Due to the significant, long-standing sales and marketing of Applicant's HOT WHEELS products under the HOT WHEELS mark and logo, HOT WHEELS has become famous in the United States and throughout the world and represents tremendous goodwill. *See Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 626, 635, 85 U.S.P.Q.2d 1895, 1900 (9th Cir. 2007).

B. Applicant's Use of and Application to Register MOTOWN METAL

In late 2005, Applicant created a line of five “basic” HOT WHEELS toy cars (toy cars sold individually, and marketed primarily to children, with a suggested retail price of 99 cents) and two “collector” HOT WHEELS toy cars (highly detailed toy cars sold in a pair, and marketed to adult collectors, with a suggested retail price of \$19.99) that were replicas of famous “muscle cars” produced by the “Big Three” Detroit automakers—General Motors, Ford, and Chrysler—in the late 1960s and early 1970s. A “muscle car” is a fast, high-performance car with a large, powerful V-8 engine, such as the Chevrolet Camaro, the Pontiac GTO, and the Plymouth Road Runner. (See Trial Declaration of Jan Heininger submitted by Applicant (“Heininger Decl.”), ¶ 4; Opposer’s Notice of Reliance re: Discovery Depositions, Ex. A, Deposition of Jan Heininger (“Heininger Depo.”), 37:23-38:3, 42:3-5.)

Applicant’s basic line of toy muscle cars included replicas of a 1970 Chevrolet Chevelle, a 1965 Ford Mustang, a 1970 Plymouth Road Runner, a 1967 Chevrolet Camaro, and a 1969 Pontiac GTO. The collector’s edition two-car set included a replica of a 1970 Ford Mustang “Boss” 429 and a 1969 Chevrolet Camaro. (Trial Declaration of Raymond Adler submitted by Applicant (“Adler Decl.”), ¶ 4; Applicant’s response to Opposer’s Interrogatory No. 1, attached as Exhibit B to Opposer’s Notice of Reliance re: Written Discovery Responses (“Applicant’s Response to Opposer’s Interrogatory”).)

Applicant also set about creating a name to apply to the series for marketing purposes. Applicant chose the name MOTOWN METAL for the series because of (a) the word *Motown*’s reference to and strong association with the city of Detroit, Michigan, home of the Big Three and the location where the actual cars were produced; (b) the word *metal*’s association with cars, manufacturing, strength, and toughness; and (c) the alliteration between, pronunciation of, and

identical number of syllables in the words *Motown* and *metal*. (Heininger Decl., ¶¶ 6, 7; Heininger Depo., 40:6-41:22, 48:2-16.) MOTOWN METAL was the first name that Applicant’s copywriter (a Michigan native and car enthusiast) thought of for this series of toy cars. It took him only five minutes to come up with the name; he believed he had “nailed it” due to *Motown*’s inherent association with Detroit and the pleasant alliteration between *Motown* and *metal*. (Heininger Depo., 41:10-22, 46:20-22; Heininger Decl., ¶¶ 5, 7.)

On November 10, 2005, after conducting a trademark search and approving the MOTOWN METAL mark for use in connection with the muscle car series of HOT WHEELS, Applicant filed an intent-to-use application to register MOTOWN METAL in International Class 28 for use in connection with “toys, games and playthings, namely toy vehicles and accessories therefor” (the “Application”). The Patent and Trademark Office (“PTO”) examined the Application and published the Application for opposition on December 12, 2006.²

Applicant began selling the MOTOWN METAL toy cars in commerce in 2006 and sold them through 2007. (Adler Decl., ¶ 3.) The MOTOWN METAL mark only appeared on Applicant’s packaging in conjunction with the larger and more prominent HOT WHEELS mark:



² The PTO did not cite any potentially confusing marks, including Opposer’s mark, when reviewing the Application for publication.

(*See also* Opposer’s Notice of Reliance re: Produced Evidence, Ex. A.) Opposer filed a Notice of Opposition on or about April 11, 2007 and an Amended Notice of Opposition on or about May 29, 2007.

C. Motown Is Synonymous With the City of Detroit, Michigan

Applicant chose the mark MOTOWN METAL for its series of classic Detroit muscle car toys because *Motown* is synonymous with Detroit. This meaning is commonly understood by the consuming public and is the only one that makes sense in the context of Applicant’s toy cars.

1. Definitions of *Motown*

English dictionaries clearly demonstrate that the word *Motown* means the city of Detroit, Michigan.³ For example, *Webster’s College Dictionary* defines *Motown* ***only two ways***:

“**1.** Detroit, Michigan: a nickname. **2.** an upbeat, often pop-influenced style of rhythm and blues ***associated with Detroit*** and with numerous black vocalists since the 1950s.” (Applicant’s Notice of Reliance re: Printed Publications, Ex. A, Vol. 3, pp. 313-316 (emphasis added).) There is no mention in this definition—or indeed in most definitions of *Motown*—of Opposer, the Motown record company, or Opposer’s rights in or use of MOTOWN as a mark. (*See id.*, pp. 334-338.) In the rare instance when a dictionary does mention the Motown record label, such definition comes ***after*** both Detroit and the Motown style of music and is explicitly defined as being derived from a nickname for Detroit. (*See, e.g., id.*, pp. 332-333 (“recording label launched 1960 by Berry Gordy, Jr., from Mo(tor) Town, nickname for Detroit.”).)

³ Dictionary definitions are highly probative evidence that a word has a certain meaning in popular usage. *See* McCarthy, § 11:69 (“The Trademark Board will take judicial notice of a dictionary definition to help determine if a term has an accepted descriptive meaning.”) (citing *In re Patent & Trademark Services, Inc.*, 49 U.S.P.Q.2d 1537 (T.T.A.B. 1998)); § 12:13 (“dictionary definitions are relevant and sometimes persuasive in determining public usage. This is based on the assumption that dictionary definitions ‘usually reflect the public’s perception of a word’s meaning and its contemporary usage.’”) (citing, among other cases, *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 10 U.S.P.Q.2d 1748 (2d Cir. 1989) (dictionary definitions are “influential” because they reflect the general public’s perception of a mark’s meaning and implication)).

The Oxford English Dictionary also describes the etymology of *Motown* as “shortened [from] *Motor Town*, **nickname for Detroit**, a city noted for its vehicle-manufacturing industry. Compare: MOTOR CITY, *n.*” It defines *Motown* as, first, “[d]esignating, relating to, or in **the style of music** that blends soul and pop styles, originally made popular in the 1960s by black musicians and singers recording for the Motown Record Corporation,” and second, “[t]he city of **Detroit itself.**” (*Id.*, pp. 317-319 (emphasis added).)

2. Press and Media References to Detroit as “Motown”

Press and media references from around the United States and the world confirm that *Motown* is used interchangeably to mean both Detroit and the American automobile industry.⁴ The evidence of this pervasive usage is too voluminous to summarize here, so Applicant draws the Board’s attention to only a few notable examples in this brief.

Two recent events highlight the fact that *Motown* is synonymous with Detroit. The first is the recent collapse and subsequent government bailout of the Detroit car industry. As early as 2003, *Business Week* asked the question “Can Motown Get Out of This Funk?” *Business Week* clearly was not referring to Opposer’s record label or any “funk” that it might be in, but was referring to the Detroit auto industry. (*Id.*, pp. 350-352.) In 2008, when the auto industry’s collapse was well under way, other prominent publications such as *Forbes* (*id.*, Vol. 4, pp. 417-420, “Bush’s Motown Turnaround”) and the *Wall Street Journal* (*id.*, pp. 433-435, “Green Ink: Oil’s Down, Motown Drowns”) all published articles referring to Detroit as “Motown.” Using “Motown” to mean “Detroit” is not just an Americanism; in November 2008 British newspaper *The Independent* published an article entitled “The American Dream Shudders to a Halt in

⁴ Applicant submitted over 300 articles from the last ten years—most of which are from the last three years—referring to Detroit or the American automobile industry as “Motown.” (See Applicant’s Notice of Reliance re: Printed Publications, Ex. A, Volumes 3-7, and supplemental Notice of Reliance re: Printed Publications, Ex. A, Volumes 1-2.)

Motown.” (*Id.* pp. 410-412.) These authors all used “Motown” to signify *a place*: Detroit, Michigan. It would be nonsensical to describe President Bush turning around Opposer’s record company, or Opposer’s company drowning because of the price of oil, or the American dream shuddering to a halt in Opposer’s record label.

Ironically, in the midst of the automotive industry meltdown, *Newsweek* published an article in 2008 that compared the rampant success of Applicant’s HOT WHEELS toy cars with the declining sales of Detroit’s actual cars. In an article titled “How a Tiny Toy Makes Big Bucks,” *Newsweek* wrote “[i]n fact, as Motown melts down, Hot Wheels is heating up.” (Applicant’s supplemental Notice of Reliance re: Printed Publications, Vol. 1, Ex. A, p. 12.)⁵

The second recent event highlighting the public’s connection of *Motown* with Detroit was the “Final Four” of the NCAA men’s college basketball tournament held in Detroit in March 2009. Numerous press articles, including articles in Detroit newspapers, refer to the teams’ progression through the tournament as “the road to Motown” or “the march to Motown.”⁶ (*See* Applicant’s Notice of Reliance re: Printed Publications, Ex. A, Vol. 5, pp. 471-476, 480-485.) Sports television network ESPN captioned its coverage of the tournament the “March to Motown” and had a “March to Motown Blog” on its popular website. (*Id.*, p. 417.) It is beyond obvious that sixty-four college basketball teams were not competing to go to Opposer’s record label or to do anything remotely connected with Opposer. They were competing to be one of the final four teams in the tournament and play for the national championship *in Detroit*.

⁵ This articles has nothing to do with and contains no references to Applicant’s MOTOWN METAL toy cars.

⁶ Applicant submitted over 30 articles from a span of just two months—March and April 2009—referring to Detroit as “Motown” in the context of the NCAA Final Four. (*See* Applicant’s Notice of Reliance and supplemental Notice of Reliance re: Printed Publications, Ex. A., Vols. 5 and 6.)

In light of this overwhelming evidence, it is ludicrous for Opposer now to contend that “the MOTOWN Mark does not designate a geographical location.” (Opposer’s Brief, p. 17.) Every reader of these articles, and every other article submitted by Applicant, clearly and immediately understands that “Motown” refers to Detroit in the context of the articles. The foregoing evidence of *Motown* meaning Detroit simply overwhelms Opposer’s scant and self-serving evidence that *Motown* refers only to Opposer, its record label, or its mark.⁷ Importantly, in contrast to Applicant’s evidence of *Motown*’s connotations among the consuming public, Opposer submitted *no evidence* of how the consuming public perceives the word *Motown*. Opposer’s evidence consists only of self-serving declarations of its “sales and marketing expert” and licensees. Opposer could have, but did not, attempt to submit survey evidence or testimony from actual consumers showing that the public automatically associates *Motown* with Opposer. Undoubtedly, this is because *Motown* means Detroit.

3. The PTO Recognizes MOTOWN as Geographically Descriptive

For over a decade, the PTO has recognized that MOTOWN is geographically descriptive. Several marks consisting of or incorporating MOTOWN have been placed on the Supplemental Register because they were found by the PTO to be geographically descriptive. *See* 15 U.S.C. § 1091; *see also* McCarthy, § 14:26 (primarily geographically descriptive marks may only be registered on the Supplemental Register absent proof of secondary meaning).

For example, MOTOWN registered by the Ford Motor Company for use in connection with “accounts receivable services” and “financial services” was relegated to the Supplemental Register in 2003 because the PTO found that “[t]he primary significance of the term

⁷ *See, e.g.*, Caparis Decl., ¶ 9 (“Any association of Motown in the minds of consumers with the city of Detroit is an association derived from the previous and ongoing fame and power of the Motown mark.”); Declaration of Jerry Juste submitted by Opposer (“Juste Decl.”), ¶¶ 4-13.

‘MOTOWN’ is geographic, and applicant’s goods/services come from the place named in the mark.” (See Applicant’s Notice of Reliance re: Printed Publications, Ex. A, Vol. 1, pp. 30-31, 116-119). The PTO noted that “[a]s shown by the definitions and articles found on the Internet, MOTOWN refers directly to the largest city in Michigan, specifically, Detroit, where the major manufacturers of motor vehicles, such as the applicant, are located.” (*Id.*, p. 117.)

Similarly, in 2000 the PTO relegated to the Supplemental Register another MOTOWN mark used on “automotive engine casings” because “the primary significance of MOTOWN is geographic, and applicant’s goods come from the geographic place named in the mark.” (*Id.*, pp. 40-41, 57-58.) It is clear that where, as here, the goods in question are automotive or car-related, MOTOWN has a primarily geographic significance.

4. Many Third Parties Have Registered and Use MOTOWN

Many third parties have registered or sought to register MOTOWN or a mark containing MOTOWN to convey an association with Detroit, cars, or the Motown style of music. (See *id.*, Vols. 1-3, pp. 1-312.) “Third party registrations are probative evidence of the meaning of a word, in the same way that a dictionary can be used.” McCarthy § 11:69; *see also Institut Nat. Des Appellations D’Origine v. Vintners Int’l Co., Inc.*, 958 F.2d 1547, 1581, 22 U.S.P.Q.2d 1190, 1196 (Fed. Cir. 1992) (“third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance”); *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953, 1955 (T.T.A.B. 2006) (“Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived....”).

Significantly, the PTO allowed the mark MOTOWN MISSILE to be registered on the Principal Register for use in International Class 28 in connection with “toy vehicles,” exactly the use and Class claimed by Applicant here. (Applicant’s Notice of Reliance re: Printed Publications, Ex. A, Vol. 1, pp. 38-39.) One wonders how Opposer can credibly oppose

Applicant's mark when a two-word mark for a toy vehicle with the structure "MOTOWN [two syllable word beginning with *M*]" has been registered on the Principal Register.

There is also substantial evidence of third party *use* of MOTOWN as a mark to signify an association with Detroit. For example, a car club in Detroit uses the mark MOTOWN MUSCLE. (*Id.*, Vol. 4, pp. 379-380.) A writers group in Detroit uses the mark MOTOWN WRITERS NETWORK. (*Id.*, pp. 381-382.) An "Ultimate Frisbee" tournament was held at the Detroit Polo Club under the title MOTOWN THROWDOWN. (*Id.*, p. 383.) www.MotownGirl.com is a "comprehensive website established in May 2001 that is dedicated to helping people learn how to style and manage their natural hair at home." (*Id.*, pp. 386-388.) A wig company marketing to African American women uses the mark MOTOWN WIGS. (*Id.*, p. 389.) A motorcycle dealership in Detroit uses the mark BIKER BOB'S HARLEY-DAVIDSON MOTOWN. (*Id.*, p. 390.) There is a MOTOWN HOG motorcycle club (*id.*, pp. 392-394), a MOTOWN FIRST FEDERAL CREDIT UNION (*id.*, pp. 395-397), and even a MOTOWN CRICKET CLUB (*id.*, p. 391), all located in Detroit. None of these businesses or groups use MOTOWN to create an association with Opposer, but rather to describe their location in and affiliation with Detroit.

5. Berry Gordy Selected the Word *Motown* to Evoke Detroit

Opposer's attempt to argue that MOTOWN's use as a mark predates its use as a nickname for Detroit is irrelevant and disingenuous. First, the genesis of a mark does not matter; what matters is current perception among consumers, which Opposer fails to address. But second, Opposer's MOTOWN mark was specifically intended to convey an association with Detroit. The founder of Motown Records, Detroit native Berry Gordy, Jr., admits that the MOTOWN mark was conceived from, inextricably associated with, and meant to evoke Detroit.

I wanted something that meant more to me, *something that would capture the feeling of my roots—my hometown. Because of its*

thriving car industry, Detroit has long been known as the “Motor City.” In tribute to what I always felt was the down-home quality of warm, soulful country-hearted people I grew up around, *I used “town” in place of “city.”* A contraction of “Motor Town” gave me the perfect name—*Motown*.

(Caparis Decl., Ex. 2 (emphasis added); *see also* Opposer’s response to Applicant’s Interrogatory No. 19, attached as Exhibit B to Applicant’s Notice of Reliance re: Written Discovery Responses (“Opposer’s Response to Applicant’s Interrogatory”).) Manifestly, MOTOWN did not spring *sui generis* from Gordy’s mind; it always signified and was meant to evoke Detroit. Opposer admits this fact, as it must, both in citing the above quote and in its own deposition testimony.

(Applicant’s Notice of Reliance re: Discovery Depositions, Deposition of Jeff Moskow attached as Exhibit A thereto (“Moskow Depo.”), 53:17-24.)

According to its creator, MOTOWN is nothing more than a contraction and slight alteration of the well known “Motor City” nickname for Detroit, a nickname that *predates* the MOTOWN mark. (See Caparis Decl., Ex. 2; Opposer’s Response to Applicant’s Interrogatory No. 19 (“Because of its thriving car industry, Detroit has long been known as the ‘Motor City.’”); Applicant’s Notice of Reliance re: Printed Publications, Vol. 3, p. 344 (“Detroit had long been known as the Motor City because of the car industry.”).) Opposer’s mark is MOTOWN instead of MOCITY only because Gordy liked the “warm,” “homey” sound of *town* better than *city*. Either way, the mark was meant to mean—and does mean—Detroit.

D. Motown Signifies a Genre of Popular Music

In addition to being a synonym for Detroit, *Motown* describes a genre of popular music. The dictionary definitions of *Motown* cited above define it, after the city of Detroit, as “an upbeat, often pop-influenced style of rhythm and blues associated with Detroit” and a “style of music that blends soul and pop styles.” (Applicant’s Notice of Reliance re: Printed Publications,

Ex. A, Vol. 3, pp. 313-319.) Motown is a style and genre of music, like “rock,” “jazz,” or “R&B.” (See generally Trial Declaration of Lawrence Ferrara, PhD., submitted by Applicant (“Ferrara Decl.”), ¶¶ 2-11, Exs. B-J.) *The New Grove Dictionary of Music and Musicians* states that, while MOTOWN is a registered trademark of Opposer, it “has also come to be used as a **descriptive term** for the associated musical style.” (*Id.*, ¶ 2, Ex. B (emphasis added).)

It is irrefutable that *Motown* means a style of music—beyond the music distributed by Opposer—because a number recording artists are associated with the Motown style or referred to as “Motown artists” despite the fact that ***they never signed with, recorded for, or released music on the Motown record label.*** (*Id.*, ¶¶ 2, 12-15, Exs. K-N.) A biography of the legendary Aretha Franklin is titled *Aretha Franklin: Motown Superstar*, although she never recorded or released any music on Motown or any label owned by Opposer. (*Id.*, ¶ 12, Ex. K.) Likewise, performing icon Tina Turner has been referred to as a “Motown legend,” but she too was never signed to Motown Records. (*Id.*, ¶ 13, Ex. L.) How could these performers possibly be “Motown superstars” or “Motown legends” when they never recorded for Motown? Because they are among the most famous purveyors of the Motown style of music.

Opposer’s silence about these facts speaks volumes, and its claim that the testimony of Applicant’s expert musicologist somehow proves that “the ‘Motown Style’ specifically refers to Opposer as the source of that style” (Opposer’s Brief, p. 21) is plainly wrong. *Motown* in the context of music means far more than merely the artists who were or are affiliated with Opposer’s record label or the label itself. Just as *Motown* signifies a city in Michigan, it also signifies a genre of music—one that extends beyond just those artists who recorded for Opposer.

E. Opposer Has Not Used MOTOWN in Connection with Toys or Toy Vehicles

Applicant has applied to register MOTOWN METAL in International Class 28 for use with “toys, games, and playthings, namely, toy vehicles and accessories therefor.” Opposer concedes that it has no registrations for MOTOWN in International Class 28, for “toys, games, or playthings,”⁸ or for “toy vehicles and accessories therefor.” (*See* Opposer’s Brief, pp. 14-15 and n.3; Answer to Amended Counterclaim to Cancel and/or Limit Trademark Registrations (“Answer to Counterclaim”); ¶ 4.)

Furthermore, Opposer admits that it has made *no use* of the MOTOWN mark in connection with toy vehicles or accessories therefor. (*See* Amended Notice of Opposition, Attachment B (describing Opposer’s alleged common law rights in MOTOWN in connection with only “board games” and “karaoke”); Answer to Counterclaim, ¶ 6 (Opposer “avers that it has not used the marks MOTOWN and/or MOTOWN and Design in connection with motor vehicles, including toy vehicles and accessories therefor”); Opposer’s response to Applicant’s Interrogatories Nos. 2 and 8; Opposer’s Response to Applicant’s Request for Admission No. 10, attached as Exhibit C to Applicant’s Notice of Reliance re: Written Discovery Responses (“Opposer’s Response to Applicant’s Request for Admission”); Moskow Depo., 51:2-13.)

Opposer bears the burden of proving that it uses MOTOWN in connection with “toys, games, and playthings.” Since Opposer has no registrations for MOTOWN in that category, Opposer is forced to rely on its purported common law use of the MOTOWN mark. (*See* Amended Notice of Opposition, ¶ 4, Attachment B.) However, Attachment B to Opposer’s Amended Notice of Opposition, purporting to describe Opposer’s common law usage of

⁸ Applicant notes that the designation “toys, games, and playthings” is too broad to permit registration in any event. Opposer would be required to narrow such an identification of goods to reference the specific type of toy or game (*e.g.*, a board game, toy figures, dolls, or toy vehicles).

MOTOWN in connection with toys, games, and playthings, *is not evidence* of such use. “[A]n exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.” Trademark Rule of Practice 2.122(c). Opposer did not introduce this Attachment B as evidence during its testimony periods.

Opposer attempts to rely on evidence that it has licensed the MOTOWN mark for use in connection with “toys, games, and playthings.” (Opposer’s Brief, pp. 9-12; assorted third party declarations submitted by Opposer). But even a cursory examination of these purported “toys” reveals that each is (a) *not* a toy; (b) a strictly music-related product; and/or (c) available exclusively in a Motown memorabilia store located—where else?—in the Detroit airport.

Opposer identifies the following purported “toys” that use the MOTOWN mark: a video game called “Karaoke Revolution” (Opposer’s Brief, p. 9); a board game called “Motownopoly” (*id.*, p. 10); a Karaoke machine and related software (*id.*); “Hit Clips” and “Tooth Tunes” products (*id.*, p. 11); and MOTOWN-branded souvenirs including a stuffed bear, a novelty pencil, a light-up ball, a mood light, a harmonica keychain, and a jumbo novelty pen. *Id.*⁹

Each of the foregoing products is directly related to Opposer’s business as a record company. A karaoke machine is sound equipment; while fun to use, it is simply not a “toy.” The Motownopoly board game—described as “the game about the music that changed America!”—is a replica of the classic Monopoly board game with the street names changed to the titles of Motown songs. (Opposer’s Waddell Decl., ¶ 6, Exs. L, M; Schulte Decl., ¶¶ 2-5, Exs. 1, 2.) Hit Clips are plastic hand-held devices that play snippets of songs when a button is pressed (Moskow Depo., 59:8-14, 61:19-22); Tooth Tunes is an electric tooth brush that plays

⁹ Opposer also identifies comic books sold by a predecessor that employ a MOTOWN mark (*id.*, p. 12) but does not explain how comic books are toys, games, or playthings.

music (*id.*, 41:15-21, 42:18-43:15); the “novelty pencil” is shaped like a guitar (*id.*, 35:19-36:6); the novelty pen is shaped like a microphone (*id.*, 27:25-28:7); and a harmonica is a musical instrument. The balance of the assorted trinkets claimed by Opposer to be “toys” are in reality souvenirs available for purchase in a Motown memorabilia store in the Detroit airport (appropriately located, according to Opposer, because Detroit is the “[h]ome of the Motown label”). (*Id.*, 47:18-21.) This is the **only** place they are sold. (*Id.*, 72:8-21, 73:21-74:5.) Opposer’s self-serving declarations that MOTOWN is used in connection with “toys” cannot contradict its own testimony clearly showing that these objects are **not** toys.

V. ARGUMENT

Motown has multiple definitions and usages. Depending on the context, the public is able to discern which meaning—Detroit, a style of music, or Opposer’s mark—is intended. Here, Applicant’s use of *Motown* in connection with toy cars unambiguously suggests only Detroit. Accordingly, there can be no likelihood of confusion and no dilution of Opposer’s mark.

In order to prevail, Opposer must prove that it has valid grounds on which to oppose Applicant’s registration of MOTOWN METAL. *See* TBMP § 309.03; McCarthy, § 20:6. Specifically, Opposer has pled and must prove that (a) Applicant’s mark so resembles Opposer’s mark as to be likely, when used on or in connection Applicant’s goods, to cause confusion, or to cause mistake, or to deceive (Lanham Act § 2(d), 15 U.S.C. § 1052(d)); or (b) Applicant’s mark would dilute the distinctive quality of Opposer’s allegedly famous mark (Lanham Act § 43(c), 15 U.S.C. § 1125(c)). *See* TBMP § 309.03(c).

Opposer has not met its burden of proof on either of these grounds. The MOTOWN mark is not inherently distinctive and therefore only entitled to legal protection insofar as it has acquired secondary meaning. And it has no secondary meaning with respect to toys or toy

vehicles, the goods on which Applicant uses its mark. Because of the limited scope of MOTOWN's distinctiveness and fame, and due to the totality of other relevant factors, there is no likelihood of confusion between the marks and no dilution of Opposer's mark.

A. The MOTOWN Mark Is Descriptive at Best

Opposer's mark is entitled to legal protection only to the extent that it is "distinctive." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). In order to be distinctive, it must either be inherently distinctive or, if not, have acquired distinctiveness through "secondary meaning." *Id.* at 769. The MOTOWN mark is not inherently distinctive; if not generic, it is at best merely descriptive (both geographically and as a style of music) and thus must have acquired secondary meaning in order to be entitled to any trademark protection. *Id.* However, the MOTOWN mark has no secondary meaning in any sphere other than (arguably) music and music-related products. It is entitled to no protection in the toy market.

1. MOTOWN Is Geographically Descriptive

"A mark is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product or service." *In re MBNA America Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2004); *PaperCutter, Inc. v. Fay's Drug Co., Inc.*, 900 F.2d 558, 563 (2d Cir. 1990). "Terms that are descriptive of the geographic location or origin of goods and services are regarded by law as not being 'inherently distinctive' marks." McCarthy, § 14:1.

As the evidence unequivocally establishes, MOTOWN is a synonym for Detroit. "A 'geographically descriptive term' is any noun or adjective that designates geographical location and would tend to be regarded by buyers as descriptive of the geographic location of origin of the goods or services." McCarthy, § 14:2; *see also In re Cox Enters., Inc.*, 82 U.S.P.Q.2d 1040 (T.T.A.B. 2007) (finding THEATL to be descriptive of Atlanta, Georgia; affirming refusal to

register the mark under § 2(e)(1)); *Nike, Inc. v. Bordes*, Opp. No. 91178960 (Sept. 30, 2009) (finding B-MORE to be descriptive of Baltimore, Maryland; granting summary judgment).

Opposer's attempts to distinguish *Nike, Inc. v. Bordes* are unpersuasive; the case is directly on point. Opposer claims that, "unlike here," the term B-MORE "was derived from and chosen in part for the slang nickname for the city of Baltimore." As Berry Gordy's own words and Opposer's testimony demonstrate, MOTOWN was derived from a slang nickname for the city of Detroit. Opposer claims that, "unlike here," the applicant's business was located in Baltimore, the city described. Motown Records was located in Detroit until the 1970s and is still associated with Detroit (as demonstrated by the fact that the sole Motown Records memorabilia shop is located in the Detroit airport). Opposer claims that, "unlike here," the PTO had previously considered the phrase B-MORE to be geographically descriptive. The PTO has similarly considered MOTOWN to be geographically descriptive. (*See generally* Opposer's Brief, n.5; Sections IV.C.3 and IV.C.5 *supra*.)

MOTOWN is primarily geographically descriptive of Detroit because the public makes a "goods/place" association between Opposer's products and Detroit. *See* McCarthy, § 14:28 ("The party who challenges a registered mark as being primarily geographically descriptive has no burden to demonstrate that the territory named is 'noted for' the goods in question. All that is needed is to prove a goods/place association."). In order for a mark to be primarily geographically descriptive, it is only necessary "that the mark ... is the name of a place known generally to the public, and that the public would make a goods/place association, i.e. believe that the goods [bearing] the mark ... originate in that place." *In re California Pizza Kitchen, Inc.*, 10 U.S.P.Q.2d 1704, 1705 (T.T.A.B. 1988).

It is indisputable that “Motown” is a primary nickname of a place generally known to the public. Moreover, it is indisputable that Opposer’s goods “came from” Detroit for over 10 years and that the “Motown sound” originated in and is still intimately connected with Detroit. (*See* Juste Decl., ¶¶ 4-13; Caparis Decl. ¶ 9, Ex. 13; Applicant’s Notice of Reliance re: Printed Publications, Ex. A.) It is thus presumed that the public associates Opposer’s goods with the city of Detroit. “Where there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed....” *California Pizza Kitchen*, 10 U.S.P.Q.2d at 1705.

Opposer’s argument that “the MOTOWN Mark does not designate a geographical location” because it “*pre-dated* any reference to Detroit as ‘Motown,’ and continued to act as Opposer’s trademark long after the record company left Detroit in the early 1970s” is both incorrect and misses the point. (Opposer’s Brief; p. 17 (emphasis original).) **First**, as shown above and in Opposer’s own evidence, it is disingenuous to argue that the use of MOTOWN as a mark predated its use to refer to Detroit. The two uses were simultaneous; Berry Gordy created the MOTOWN mark from—and to function as—a geographically descriptive term for Detroit.

Second, Opposer’s authority for the proposition that a designation first used as a trademark that later becomes associated with a place can never be primarily geographically descriptive is readily distinguishable. In *In re Pebble Beach Co.*, the Board found that, because the mark in question referred to “*a place owned by applicant*, to the extent [the mark] is descriptive of goods or services originating at that location it is identifying goods or services originating with applicant.” 19 U.S.P.Q.2d 1687, 1688 (T.T.A.B. 1991) (emphasis added). “[B]ecause applicant owns, maintains and controls the area known as ‘17 Mile Drive,’ there can

be no other parties located in that area with rights to describe the geographic origin of their goods and services by using applicant's designation....” *Id.* Here, because Opposer does not own the city of Detroit, *Pebble Beach* does not apply. Other parties are free to describe the geographic origin of their goods and services as “Motown.” The counter-argument would be akin to claiming that the mark MATTEL is geographically descriptive of Applicant's offices in El Segundo, California because Applicant owns the buildings or the land they sit on.¹⁰

Third, even if its use as a mark did predate its use as a geographic descriptor (which is not so), it is indisputable that MOTOWN has *since* come to signify Detroit. Opposer's quote “Nashville has country music. Chicago has the blues. New Orleans has Dixieland. And Detroit will always identify itself with Motown...” makes this clear. (Caparis Decl., Ex. 14.) The author means that the public associates Nashville with country music, Chicago with the blues, New Orleans with Dixieland jazz, and Detroit with the Motown style of music. But Nashville is not commonly (or ever) referred to by the nickname “Country Music.” Chicago is not referred to as “Blues.” New Orleans is not referred to as “Dixieland.” But refer to “Motown,” and the public immediately knows which city is being referenced. That is the crucial distinction. Even if its use as a mark preceded its use as a synonym for the city (which it did not), MOTOWN has come to signify the place; it has become a victim of geographic “genericide.” *See* McCarthy, § 14:18 (“Some geographic terms come to signify a certain product.... That is, the geographic term names a kind of product. When that happens, the term cannot serve as a trademark to distinguish one seller or even one group of sellers in a certain territory.”).

¹⁰ Opposer's other authority for this argument, *Scheder v. Touristik Arbeitsgemeinschaft Romantische Strasse GBR*, 2007 WL 1849136 (T.T.A.B. 2007), is also distinguishable. The mark in that case “developed a reputation connoting tourism in a particular geographic region....” *Id.* at *3. It did not come to connote the place itself as MOTOWN connotes Detroit. Furthermore, this case is not precedential and not binding on the Board. *See* Official Gazette Notice of 23 January 2007.

2. MOTOWN Describes a Genre of Popular Music

Motown also describes a genre of music, just as do the words *rock*, *soul*, or *jazz*. (See Section IV.D, *supra*.) In fact, the Motown genre extends beyond Opposer because it encompasses more than just music recorded or distributed by Opposer. (Ferrara Decl., ¶¶ 12-15, Exs. K-N.)

3. Opposer's Use of MOTOWN Is Descriptive, Not Suggestive

MOTOWN is plainly a descriptive mark, whether geographically or of a genre of music. In the event that Opposer attempts to argue MOTOWN is suggestive rather than descriptive, and thus inherently distinctive, the tests customarily used to distinguish between descriptive and suggestive marks clearly demonstrate that it is merely descriptive.

The principal test for determining the descriptive-suggestive distinction is referred to as the “imagination” test. McCarthy, § 11:67. “The more imagination that is required on the customer’s part to get some direct description of the product from the term, the more likely the term is suggestive, not descriptive.” *Id.* In *PaperCutter*, for instance, the court offered “Gleem” for toothpaste as an example of a suggestive mark. 900 F.2d at 563. The example is apt. Suggestive marks like “Gleem” do not immediately convey the characteristics of a product. Rather, an inferential leap, some meaningful degree of imagination, is required to understand the relationship between the product and its name.

Here, no imagination, and no inferential leap, is needed to connect MOTOWN with Opposer’s products. To the contrary, the mark tells consumers explicitly and exactly what the product is: music or a music-related product associated with Opposer’s place of origin (Detroit) and/or with the Motown genre of music. MOTOWN is, in fact, far less imaginative (and more descriptive) than numerous marks deemed descriptive by the courts. *See, e.g., Bada*, 425 F.2d at

11 (holding that MICRO-PRECISION is descriptive of a product for balancing automobile tires); *Black & Decker Corp. v. Dunsford*, 944 F. Supp. 220, 225 (S.D.N.Y. 1996) (finding SNAKELIGHT descriptive of a light that was “flexible, and can be bent or twisted”).

Descriptive marks need not be entirely devoid of imagination. SNAKELIGHT, for example, has an imaginative metaphor. That product could be more descriptively called a “flexible extending light” rather than an illuminated snake. Yet the fact that SNAKELIGHT has some imaginative aspect did not render the mark suggestive. The same is true here. Even if Opposer’s mark has some imaginative aspect—and Applicant submits there is none—the imagination required to connect MOTOWN to Detroit is so trivial as to be nonexistent.

The second test of descriptiveness is the extent to which third parties have used the same mark. *Shoe Corp. of Am. v. Juvenile Shoe Corp.*, 266 F.2d 793, 796 (C.C.P.A. 1959); 555-1212.com, Inc. v. Communication House Int’l., Inc., 157 F. Supp. 2d 1084, 1089 (“[I]n determining whether a word has a descriptive or suggestive significance ... it is proper to take notice of the extent to which others in a similar commercial context use the word.”). Third party usage is germane because, “[i]f [a mark] has been frequently ... used, the inference is warranted that it is not purely arbitrary; that it would likely be understood by purchasers as identifying or describing the merchandise itself, rather than the source thereof, and hence as having little or no trademark significance.” *Shoe Corp.*, 266 F.2d at 796; *see also* McCarthy, § 11:69 (“if others are in fact using the term to describe their products, an inference of descriptiveness can be drawn”).

A number of third parties use MOTOWN to describe an association with Detroit. The prevalence of this use is significant. First, it shows that that suppliers use the word to describe what their product is or where it comes from, not who they are, and consumers understand this to be the case. Second, the significant third-party usage of MOTOWN suggests that the word has

little ability by itself to identify the source of products or services. In other words, why would a customer associate Applicant's use of MOTOWN with Opposer over any of the other trademark users described above? *See 555-1212.com*, 157 F. Supp. 2d at 1089 (holding commonality of telephone number 555-1212 rendered 555-1212.com descriptive of an Internet directory service).

The third test for descriptiveness, the "competitors' need test," further supports that Opposer's trademark is merely descriptive. As stated by Professor McCarthy, "If ... the message conveyed by the mark about the goods or services is so direct and clear that competing sellers would be likely to need to use the term in describing or advertising their goods, then this indicates that the mark is descriptive." McCarthy, § 11:68. *See also Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1218-1219 (9th Cir. 1987); *Security Ctr., Ltd. v. First Nat. Sec. Ctrs.*, 750 F.2d 1295, 1299 (7th Cir. 1985) (holding that the determination of descriptiveness considers "whether sellers ... are likely to use" the term).

The competitors' need test stems from the principle that trademark registrations may not monopolize words and thereby grant registrants the functional equivalent of a patent. Descriptive marks "may not be appropriated as the exclusive trademark of a single seller, since one competitor will not be permitted to impoverish the language of commerce by preventing his fellows from fairly describing their own goods." *Bada*, 426 F.2d at 11. Put another way, the test for descriptiveness seeks to prevent "a 'linguistic monopoly' which would stifle competitors' efforts to market similar goods to consumers." *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997); *see also Bernard v. Commerce Drug Co.*, 964 F.2d 1338, 1342 (2d Cir. 1992) (noting courts' "concern that exclusive use of [a] term might unfairly 'monopolize' common speech").

Opposer plainly seeks just such a “linguistic monopoly.” All purveyors of products originating from or associated with Detroit or with the Motown music genre need the word to market their products because that is how city and the genre are popularly known. Opposer could argue that Applicant could have concocted a different phrase, like MOTOR CITY METAL, to apply to their toy muscle cars. But the fact that a party could theoretically substitute another word or phrase for MOTOWN begs the question. The mere existence of synonyms for MOTOWN does not render the mark any less descriptive, just like the existence of synonyms for “basketball” (*e.g.*, “hoops”) does not render the game’s name any less descriptive. Thus, were Opposer correct, Applicant and others would effectively be precluded from using the most well-known nickname for Detroit to sell products associated with Detroit. This would give Opposer patent-like protection on a word—in stark opposition to the tenets of trademark law.

The tests for descriptiveness described above, and the policy rationales underlying those tests, compel the conclusion that MOTOWN is descriptive. Little to no imagination is required for consumers to understand the nature of the products from their title, numerous third parties use MOTOWN to describe their products, and competitors need the word to describe their products to consumers. MOTOWN does not tell consumers from *whom* the product originates. It instead tells consumers *what* the product is or *where* it comes from, the hallmarks of a descriptive mark.

B. MOTOWN Has No Secondary Meaning in Connection with Any Products Beyond (Arguably) Music-Related Products

Because the MOTOWN mark is descriptive at best, it lacks trademark protection unless Opposer can demonstrate that it has acquired secondary meaning. *Two Pesos*, 505 U.S. at 769; *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995); *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 187 F.2d 590, 10 U.S.P.Q.2d 1443 (6th Cir. 1989) (geographically descriptive terms require secondary meaning for

legal protection; no secondary meaning found). Furthermore, because Opposer has no registrations for MOTOWN in connection with toys, games, and playthings and is relying on unregistered marks and purported “common law” rights in that class of goods, Opposer *must* prove that its mark has acquired secondary meaning *in connection with toys, games, and playthings*. See McCarthy, § 20:15 (“in an opposition or cancellation proceeding, the plaintiff relying on an unregistered term to argue likelihood of confusion under § 2(d) must prove distinctiveness, either by inherent distinctiveness or acquired distinctiveness through secondary meaning.”)

A descriptive trademark acquires secondary meaning when its use has become so ubiquitous in connection with the goods involved that the consuming public identifies the trademark as emanating from a single source. As stated by the Ninth Circuit, the “basic element of secondary meaning is a mental recognition in buyers’ and potential buyers’ minds that products connected with the [mark] are associated with the same source.” *Self-Realization*, 59 F.3d at 911; *see also PaperCutter*, 900 F.2d at 564 (secondary meaning exists “if the term, although not inherently distinctive, comes through use to be uniquely associated with a single source”); *Bernard*, 964 F.2d at 1343 (secondary meaning requires that “a significant number of prospective purchasers understand the term *when used in connection with the particular kinds of goods involved* ... as indicative of an association with a specific entity”) (emphasis added).

1. The Mark Must Have Secondary Meaning in the Relevant Market

Opposer must establish that its mark has acquired secondary meaning in connection with the relevant goods at issue. Marks may be strong as to one type of goods but weak as to others. *See, e.g., La Maur, Inc. v. Bagwells Enters., Inc.*, 199 U.S.P.Q. 601 (T.T.A.B. 1978) (STYLE strong for cosmetic products but weak for beauty salon services); *Mego Corp. v. Mattel, Inc.*, 203 U.S.P.Q. 377 (S.D.N.Y. 1978) (GALACTIC may be strong as to nonspace age products, but is

weak as to space toys); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 205 U.S.P.Q. 969 (5th Cir. 1980), *cert. denied*, 449 U.S. 899, 208 U.S.P.Q. 464 (1980) (DOMINO strong for sugar products but weak for other food products); *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 35 U.S.P.Q.2d 1449, 1459 (2d Cir. 1995) (Mark held strong on hand-operated stapler but not on other products. “The strength of the ... mark, however, is limited to the product that the mark identifies and others that directly compete with it.”); *see also* McCarthy, § 11:77 (“Some cases decide a trademark conflict for the junior user by saying that while plaintiff’s mark is strong in its own market, it is weak in defendant-junior user’s market.”). Here, while Opposer’s mark may be strong as to music recordings, it is unquestionably weak as to toys and has no secondary meaning in the toy market.

2. Opposer Bears a High Burden of Proving Secondary Meaning

The burden to prove secondary meaning is placed squarely upon Opposer. *PaperCutter*, 900 F.2d at 564 (“The existence of secondary meaning is a question of fact with the burden of proof on the party claiming exclusive rights in the designation.”). In the many cases cited herein, it is the party claiming registration that failed to meet the burden to prove secondary meaning. *See, e.g., 555-1212.com*, 157 F. Supp. 2d at 1091; *Bristol-Meyers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1034 (2d Cir. 1992); *Bernard*, 964 F.2d at 1343.

Furthermore, Opposer’s evidentiary burden to prove secondary meaning is rigorous and high. *PaperCutter*, 900 F.2d at 564 (“Proof of secondary meaning entails rigorous evidentiary requirements....”). Here as always, the context of use is key.

In inter partes cases, secondary meaning is not necessarily a “yes-no” or “on-off” concept. That is, it is wrong to say that a finding of secondary meaning is the end of the enquiry. Evidence of secondary meaning can be either weak or strong, and, coupled with other criteria of strength, can lead to a conclusion on the strength

or weakness of the mark *vis-à-vis the usage alleged to be an infringement*.

McCarthy, § 15:25 (emphasis added).

Stated succinctly, Opposer bears a heavy burden to establish that the public has come to associate MOTOWN, *used in connection with toys*, exclusively with Opposer. As a matter of law, Opposer has not met this burden. As detailed above, Opposer has made no use of MOTOWN in connection with toys or toy vehicles; the merchandise Opposer relies on are not toys and are all music-related products. Further, Opposer has submitted no evidence of any secondary meaning among the consuming public in any field, let alone toys. Thus, even assuming that MOTOWN has acquired secondary meaning in popular music (which, based on Opposer's lack of evidence and on *Motown's* significance as a genre of music, Applicant denies) there is no evidence that Opposer's use of MOTOWN has accorded it secondary meaning in the toy or toy vehicle markets.

3. Factors for Finding Secondary Meaning

Factors to be considered in determining secondary meaning include: (1) whether actual purchasers associate the trademark with the producer; (2) the degree of advertising; (3) the length and manner of use of the trademark; and (4) whether use of the trademark has been exclusive. *See Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985); *Black & Decker*, 944 F. Supp. at 227; *Bristol-Meyers*, 973 F.2d at 1041. Opposer fails to show *any* secondary meaning in the MOTOWN mark in connection with toys.

First, it is clear that purchasers do not “automatically” or “uniquely” associate MOTOWN with Opposer for the reasons articulated above: *Motown* means Detroit and a genre of music beyond any association with Opposer. While purchasers may associate MOTOWN with Opposer in connection with recorded music, it cannot be said that they automatically make

that association in relation to other goods. **Second**, Opposer has submitted no evidence of any advertising of toys bearing the MOTOWN mark. **Third**, the evidence submitted by Opposer proves that, while Opposer may use MOTOWN in connection with music products, its alleged use in connection with so-called “toys” (if any) is miniscule and recent, and it has made no use of its mark on toy vehicles. **Fourth**, it is indisputable that Opposer does not make exclusive use of the MOTOWN mark.

The fact that Opposer uses its mark only in connection with music-related products is alone enough to deny the Opposition. But the undisputed fact that Opposer makes no use of its mark whatsoever in connection with toy vehicles dooms it. Considering this and the other relevant factors above, including Opposer’s minimal sales of purported “toys” and the nonexistent sales of toy vehicles, it is clear that the consuming public has not come to associate MOTOWN exclusively with Opposer in the toy market. The facts compel the conclusion that MOTOWN has no secondary meaning as applied to toys or toy vehicles.

C. There Is No Likelihood of Confusion Between the Marks

Because Opposer’s mark is not inherently distinct and lacks secondary meaning in connection with toys or toy vehicles, the Opposition must be denied. However, assuming that Opposer’s mark is entitled to any legal protection at all, the Opposition still fails because there is absolutely no likelihood of confusion between Applicant’s and Opposer’s marks.

In considering whether a likelihood of confusion exists, the Board looks to the relevant factors articulated in *In re E. I. DuPont De Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Here, the relevant *DuPont* factors—(1) the dissimilarities between the marks in appearance, sound, connotation, and commercial impression; (2) the dissimilarities between the relevant goods and services; (3) the dissimilarities between the goods’ trade

channels; (4) the dissimilarities between the conditions under which, and buyers to whom, sales are made; (5) the limited “niche” fame of Opposer’s mark; (6) the number and nature of similar marks in use; and (7) the absence of any actual confusion (*id.*)—as well as Applicant’s intent in selecting its mark, clearly show that there is no likelihood of confusion.

Opposer bears a rigorous burden in this proceeding. “Likelihood of confusion” means a ***probability of confusion***; mere “possible” confusion is not enough. *See, e.g., American Steel Foundries v. Robertson*, 269 U.S. 372 (1926) (mark must “probably confuse”); *Rodeo Collection*, 812 F.2d at 1217 (“Likelihood of confusion requires that confusion be probable, not simply a possibility.”). Additionally, the mere fact that Applicant’s mark contains the word *Motown*—or even that Applicant’s mark might “call to mind” Opposer’s mark—is insufficient to conclude that they are likely to be confused.

“Likely ... to cause confusion” means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. ***It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark.*** To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to the concepts embodied in 15 U.S.C. § 1052(d).

Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imp. Co., Inc., 703 F.2d 1372, 1374, 217 U.S.P.Q. 505 (Fed. Cir. 1983) (affirming Board’s finding of no likelihood of confusion) (emphasis added); *see also* McCarthy, § 23:41 (no rule that confusion is automatically likely just because junior user’s mark contains senior user’s mark; citing cases). Because Opposer has adduced no evidence to establish that there is any reasonable basis for the public to attribute

Applicant's HOT WHEELS toys bearing the MOTOWN METAL mark to Opposer, Opposer has not shown that there is a likelihood of confusion between the marks.¹¹

1. The Dissimilarities Between the Marks Establish That There Is No Likelihood of Confusion

The first *DuPont* factor is the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 476 F.2d at 1361. On their faces, and in their entireties, the marks are not confusingly similar.

Opposer's attempt to “dissect” Applicant's mark and focus only on the word *Motown* is improper and contrary to the long-established “anti-dissection” rule of trademark law. *See, e.g., Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”); *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 28 U.S.P.Q.2d 1641 (9th Cir. 1993) (“the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace”); *Recot, Inc.*

¹¹ Opposer offers no evidence on this point. Indeed, the fact that both marks use the word *Motown* actually militates in favor of finding **no** likelihood of confusion. “If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.” McCarthy, § 23:48 (citing, among other cases, *In re America's Best Chocolate, Inc.*, 169 U.S.P.Q. 53, 1971 WL 16433 (T.T.A.B. 1971) (no likelihood of confusion between AMERICA'S BEST CANDY and AMERICA'S BEST CHOCOLATE)). *See also Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed Cir. 2004), *cert. denied* 2005 WL 2413994 (U.S. 2005) (no likelihood of confusion between RITZ and PUTTING ON THE RITZ); *Time, Inc. v. Petersen Publ'g Co.*, 173 F.3d 113, 50 U.S.P.Q.2d 1474 (2d Cir. 1999) (no likelihood of confusion between TEEN and TEEN PEOPLE); *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 26 U.S.P.Q.2d 1583 (2d Cir. 1993) (no likelihood of confusion between PARENTS and PARENTS DIGEST); *In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (no likelihood of confusion between VARGAS and VARGA GIRL); *Bell Labs., Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 231 U.S.P.Q. 569 (S.D. Fla. 1986) (no likelihood of confusion between FLIP and FINAL FLIP); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (no likelihood of confusion between ALL and ALL CLEAR); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (no likelihood of confusion between PEAK and PEAK PERIOD).

v. Becton, 214 F.3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) (reversing Board for improperly dissecting conflicting marks to determine if commercial impressions were confusing).¹²

Opposer argues that the Board should only focus on MOTOWN in Applicant's mark because, Opposer claims, METAL "is irrelevant" since it is descriptive of HOT WHEELS toys, which "are composed of metal." (Opposer's Brief, pp. 27-28.) Applicant's HOT WHEELS toys are indeed made of metal (as well as rubber and other materials), but that is not why METAL was chosen for the mark and is not what METAL conveys. Rather, METAL suggests strength, force, and toughness, attributes of the muscle cars depicted by the MOTOWN METAL series. (See Heining Decl., ¶ 6.) As Opposer points out, the MOTOWN METAL series was initially known internally as simply the "Muscle Cars" series, a plainly descriptive name. (See Caparis Decl., ¶ 11.) Applicant chose to market the toys as MOTOWN METAL rather than MUSCLE CARS precisely because such designation is suggestive of both Detroit¹³ and strength.

Throughout its brief, Opposer attempts to analogize this proceeding to *UMG Recordings, Inc. v. O'Rourke*, 92 U.S.P.Q.2d 1042 (T.T.A.B. 2009). Its efforts are unavailing; the cases are

¹² Opposer attempts to use its expert witness—an alleged "sales and marketing expert" with no relevant trademark experience—to prove that the marks "are, from a consumer standpoint, identical." (Opposer's Brief, p. 27.) Opposer's expert does not opine on the facts relevant to a likelihood of confusion analysis but rather on the ultimate question of confusion. This is not a proper use of expert witness testimony and should be disregarded. The determination of likelihood of confusion is the sole province of the Board. See *The Mennen Co. v. Yamanouchi Pharm. Co., Ltd.*, 203 U.S.P.Q. 302, 305, 1979 WL 24856 (T.T.A.B. 1979) ("opinions of witnesses, including those qualified as expert witnesses, on the question of likelihood of confusion are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question"); *The Land-O-Nod Co. v. Paulison*, 220 U.S.P.Q. 61, 63-64, 1983 WL 51867 (T.T.A.B. 1983) (same).

¹³ Opposer argues that the descriptive nature of MOTOWN "would disqualify **Applicant** from trademark protection, as Applicant is the one claiming to use it in a geographic sense...." (Opposer's Brief, p. 20 n.7 (emphasis original).) This is not the case. Applicant's use of MOTOWN is suggestive rather than descriptive of Detroit because the goods in question (HOT WHEELS toys) do not and have never come from the place named, so there is no goods/place association. Instead, Applicant's use of MOTOWN on the toys at issue suggests the city of origin of the actual cars that the toys are replicas of. An inferential leap is required to connect the toys to Detroit. See *PaperCutter*, 900 F.2d at 563; McCarthy, § 14:28.

simply not analogous. In *O'Rourke*, the applicant sought to register MTOWN CLOTHING for use in connection with clothing. *Id.* at 1043. Opposer opposed registration on the grounds of likelihood of confusion and dilution (*id.*), although it later waived the dilution claim. *Id.* at 1044. In finding a likelihood of confusion, the Board focused on the fact, among others, that the applicant had disclaimed the word CLOTHING in its mark. The Board “g[a]ve little weight to the inclusion of the disclaimed word” because “[i]t is much smaller than MTOWN and would not be viewed as distinctive and an indicator of source, for it is a generic term for applicant’s identified goods.” *Id.* at 1048. Such logic does not apply here. Applicant has not disclaimed METAL in its mark¹⁴, and METAL is not a “generic term for [A]pplicant’s identified goods.”

Not only are the marks dissimilar in appearance and sound, but they could hardly be more dissimilar in connotation and commercial impression. As shown above, the word *Motown* has several meanings, only one of which is Opposer’s mark. Applicant uses MOTOWN to suggest an association with Detroit, a widely accepted meaning of the word and, indeed, its primary definition. (See Applicant’s Notice of Reliance re: Printed Publications, Ex. A, Vol. 3, pp. 313-316.) Unlike Opposer, Applicant does not use MOTOWN to connote music.

2. The Dissimilarities Between the Goods and Services at Issue Establish That There Is No Likelihood of Confusion

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.” *In re SL&E Training Stable, Inc.* 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008). The degree of similarity between the marks needed to show a likelihood of confusion varies inversely with the difference in the parties’ goods—the more dissimilar the goods, the higher the degree of similarity between the marks required. *Fossil, Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998); *accord.* McCarthy, § 23:20.50. Just as

¹⁴ Nor was it required to in the application process.

the marks here are too dissimilar for a likelihood of confusion, the parties' goods are so dissimilar as to make a likelihood of confusion impossible.

Opposer's claim that "[t]he parties' good are identical" is, at best, disingenuous. (Opposer's Brief, p. 29.) The briefest examination of the evidence shows this is not the case. Applicant sells toy vehicles. Opposer sells music products and licenses its mark on music-related merchandise. No evidence, however, suggests that any *consumers* (as opposed to Opposer itself) consider Opposer's purported "toys" such as karaoke machines and novelty pens to be toys at all. And it is undisputed that Opposer does not sell or license, and has never sold or licensed, toy vehicles. The goods are simply not related *at all*, and no reasonably prudent purchaser would be confused that they emanate from the same source or are affiliated with, connected to, or sponsored by Opposer. *See In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 U.S.P.Q.2d 1778 (Fed. Cir. 2001) ("The related goods test measures whether a reasonably prudent consumer would believe that non-competitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner."); McCarthy, § 24:24 ("Goods are 'related' ... in the sense that buyers are likely to believe that such goods, similarly marketed, come from the same source, or are somehow connected with or sponsored by a common company.").

Opposer next claims that the goods are at least "competitive." (Opposer's Brief, p. 29.) This too is false. Although Opposer quotes McCarthy that "competitive" means "goods that are reasonably interchangeable by buyers from the same purposes" (McCarthy, § 24:23), Opposer does not attempt to explain how die-cast toy cars possibly could be interchangeable for the same purposes with music-related products like a karaoke machine or an electric toothbrush. Anyone who has raised children knows this is not the case. *See E.S. Originals, Inc. v. Stride Rite Corp.*,

656 F. Supp. 484, 492 n.14, 2 U.S.P.Q.2d 1934 (S.D.N.Y. 1987) (“The Court does not necessarily agree that sophistication of the purchaser is necessarily diminished because the product is targeted to children. A child carefully programmed by an effective advertising campaign is most likely to insist on the advertised product and is not likely to accept a substitute.”) (no likelihood of confusion between ZIPS and ZIP ‘N GO for athletic shoes).

Finally, Opposer argues that it should be allowed to monopolize MOTOWN in connection with toys because it uses its mark in products “collateral” to music. (Opposer’s Brief, pp. 30-31.) Again relying on *O’Rourke*, Opposer quotes the Board’s finding that “Opposer’s mark is famous *for musical recordings and performances*, and Opposer has demonstrated that such fame has been exploited by its use of the mark on *collateral products, including clothing*.” *O’Rourke*, 92 U.S.P.Q.2d at 1049 (emphasis added). Unlike clothing, however, no evidence suggests that toy cars are collateral to music.¹⁵ It is reasonable that Opposer would put its mark on clothing. Bands, musicians, and record labels have long licensed their marks to appear on such merchandise. But it is not reasonable to conclude that Opposer uses its mark in connection with toys to the point that consumers, “when subsequently confronted with [toys] adorned with applicant’s mark[,] would likely conclude it was another variation on the marks used by or authorized by opposer for such goods.” *Id.* at 1050.

3. The Dissimilarities of Trade Channels Establish That There Is No Likelihood of Confusion

Because Opposer relies on purported common law use of MOTOWN in connection with toys, games, and playthings, it must *prove* such use and is not entitled to any presumption that such goods travel through “all ordinary and usual channels.” Opposer fails to prove any such use

¹⁵ This is amply demonstrated by the fact that Opposer’s use of its mark in connection with toys (if any) pales in comparison to its use on true “collateral products” like clothes.

of MOTOWN in connection with toys, games, and playthings, and Opposer admits that the majority of its MOTOWN-branded “toys” are available for purchase in ***only one location***: a store in the Detroit airport. (Moskow Depo., 47:18-21, 72:8-21, 73:21-74:5.) Opposer has proven no other use. Applicant’s goods, on the other hand, are sold throughout the United States and the world (Applicant’s Supplemental Response to Opposer’s Interrogatory No. 12; Adler Depo., 81:17-23, 100:4-101:2), but not at the “Motown Store” at the Detroit airport. These are clearly not the same channels of distribution.

While it is true that, for purposes of this Opposition, Applicant’s goods are presumed to travel in “all the ordinary and usual channels of trade for such goods to all the usual customers for these products” (McCarthy, §20:15), that is not the end of the inquiry. It is wrong to assume, just because Opposer’s CDs may be available for purchase in the same “major retail stores and on the Internet” as Applicant’s toy vehicles (Opposer’s Brief, p. 32), that they are likely to be confused. As Professor McCarthy observes:

The argument that the goods are “related” in a trademark infringement sense because they are both marketed over the Internet ... suffers from the same fallacy as the old “under the same roof” argument. In the modern marketing environment of mega-sized stores selling all manner of goods, “under the same roof” is not probative of a likelihood of confusion. Similarly, in the Twenty-First Century, the Internet has become the venue for the advertising and sale of all manner of goods and services. That the goods or services of the parties are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.

McCarthy, § 24:53.50 (citing *Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 U.S.P.Q.2d 1012, 1021, 2007 WL 683784 (T.T.A.B. 2007) (“[T]he mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.”)).

4. The Conditions Under Which, and Buyers to Whom, Sales Are Made Establish That There Is No Likelihood of Confusion

Opposer claims that “[b]oth Applicant’s and Opposer’s products are ‘impulse purchases’” (Opposer’s Brief, p. 32) and that Applicant’s customers “are not sophisticated (nor need they be) in purchasing the inexpensive toy products involved.” (*Id.*, p. 34.) Again, Opposer ignores the evidence. HOT WHEELS are marketed to children and to adult collectors, both of whom are discerning customers (for different reasons).

The HOT WHEELS basic toy cars are marketed to children (primarily boys) ages three through six who choose HOT WHEELS based, first, on their shape and styling and, second, on their color. (Adler Decl., ¶ 12; Adler Depo., 64:2-18, 65:12-66:2, 115:1-10.) No evidence suggests that these young consumers (a) choose HOT WHEELS based on secondary marks like MOTOWN METAL, (b) would be confused that MOTOWN METAL is associated with Opposer, or (c) are even familiar with Opposer’s mark. Children choose the toys because they are HOT WHEELS (*see E.S. Originals*, 656 F. Supp. at n.14 (children are “likely to insist on the advertised product and ... not likely to accept a substitute”)) and because they are muscle cars, not because of any association, real or perceived, with Opposer.

The collector editions of HOT WHEELS are marketed to a specific demographic—adult collectors of HOT WHEELS cars—who are as choosy as any collector. They purchase the cars for themselves, not merely for their children, and they are car fanatics who are very knowledgeable about cars and automotive history and exercise a great deal of care in selecting their purchases. (*See* Trial Declaration of Christopher Bouman submitted by Applicant, ¶¶ 5 and 6; Opposer’s Notice of Reliance re: Discovery Depositions, Ex. D, Deposition of Christopher Bouman, 33:23-34:22, 35:16-38:19; Adler Decl., ¶ 12; Adler Depo. 114:14-115:4.) They are discriminating, not careless, and thus are not likely to be confused that Applicant’s MOTOWN

METAL toys are associated with Opposer.¹⁶ *See West Point-Pepperell, Inc. v. Borlan Indus., Inc.*, 191 U.S.P.Q. 53 (T.T.A.B. 1976) (test is whether use of marks “would be likely to cause confusion, mistake or deception of average reasonably prudent purchasers”).

5. The Limited, “Niche” Fame of Opposer’s Mark Establishes That There Is No Likelihood of Confusion

Opposer makes much of the alleged widespread fame of its mark, arguing that such fame compels the Board to find a likelihood of confusion with Applicant’s mark per se. But Opposer’s mark is only famous within a limited sphere—recorded music. The limits of its fame are apparent from the fact that *Motown* means several things to consumers beyond Opposer’s mark, *i.e.* MOTOWN does not **only** call to mind Opposer. (*See* Sections IV.C and D. *supra*.) The limits of its fame have also been recognized by courts and the Board. *See, e.g., O’Rourke*, 92 U.S.P.Q.2d at 1049 (MOTOWN famous “in the music industry” and “for musical recordings and performances”); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000) (same). In *O’Rourke*, it was the fact that MOTOWN’s limited fame “has been exploited by its use on collateral products, including clothing” that compelled the finding that applicant’s use of MTOWN on clothing was likely to be confused with Opposer’s use on clothing. *Id.* at 1049-50.

No evidence suggests that MOTOWN is famous in any market beyond recorded music, and certainly not in the toy market. While its niche fame in music may preclude others from selling music-related products using MOTOWN, it cannot preclude others from using

¹⁶ Opposer misleadingly claims, based on its expert’s testimony, that Applicant sought to create an association with Opposer because “Motown had a widely publicized 40th Anniversary campaign ..., and Mattel released a ‘40th Anniversary Motown Metal’ two-car collector set.” (Opposer’s Brief, p. 34). As the Board can plainly see, however, the 40th anniversary that Applicant’s collector set packaging referred to was the 40th anniversary **of HOT WHEELS, not** of Motown. (Caparis Decl., Ex. 20.) Moreover, Motown’s 40th anniversary occurred in 1998 (*id.*, Ex. 9), while HOT WHEELS’ occurred eight years later in 2006 (*see* Section IV.A *supra*).

MOTOWN to suggest or describe a relationship to Detroit, and it cannot preclude others from such uses in markets unrelated to music.

6. The Number and Nature of Similar Marks in Use Establish That There Is No Likelihood of Confusion

As Applicant's evidence demonstrates, numerous third parties use MOTOWN to advertise a connection with Detroit. (*See* Section IV.C.4 *supra*.) This vast third party usage is relevant because, "[i]f [a mark] has been frequently ... used, the inference is ... that it would likely be understood by purchasers as identifying or describing the merchandise itself, rather than the source thereof, and hence as having little or no trademark significance." *Shoe Corp.*, 266 F.2d at 796. Consumers are not confused because they can distinguish between MOTOWN as signifying Opposer's products and MOTOWN as signifying Detroit.

7. The Lack of Actual Confusion Establishes That There Is No Likelihood of Confusion

While actual confusion is not required to prove a likelihood of confusion, evidence of actual confusion is nonetheless powerful and is the best indicator of a likelihood of confusion. *See* McCarthy, § 23:13 ("Any evidence of actual confusion is strong proof of the fact of a likelihood of confusion."). As Opposer admits, there is *no evidence* of any actual confusion in this case. (Opposer's Response to Applicant's Request for Admission Nos. 8 and 9.)

8. Applicant's Intent in Selecting MOTOWN METAL Establishes That There Is No Likelihood of Confusion

Although not a *DuPont* factor, an applicant's intent in selecting a mark is relevant to an analysis of likelihood of confusion. McCarthy, § 23:79. Opposer contends that "Applicant intended to trade on Opposer's goodwill in the MOTOWN Mark in adopting and using MOTOWN METAL." (Opposer's Brief, p. 36.) This, however, again ignores the evidence.

Applicant's employee who created the MOTOWN METAL mark testified that his intention was to create a link in the purchaser's mind with classic Detroit muscle cars. (Heininger Depo., 41:10-22, 48:2-16, 63:17-65:7.) Mr. Heininger was of course familiar with Opposer's mark when he coined MOTOWN METAL; he associated it with music, not toys. (*Id.*, 66:2-67:14). His familiarity with Opposer's mark is not, however, evidence of an intent to trade off its goodwill or to confuse consumers. McCarthy, § 23:155 ("[T]he mere fact that the accused is aware of the senior user's mark does not per se prove that intent [to confuse]"); *see also Brockmeyer v. Hearst Corp.*, 248 F. Supp. 2d 281, 299 (S.D.N.Y. 2003) (awareness of senior user's mark not evidence of bad faith when junior user reasonably believes there is no likelihood of confusion). Applicant reasonably believed that, in connection with its toy cars, there would be no likelihood of confusion between its mark and Opposer's. (Heininger Depo., 68:8-18, 69:15-70:2, 70:23-71:8.) Applicant did not intend to trade off Opposer's mark but rather to suggest a connection between its toy muscle cars and Detroit.

D. Applicant's Use of MOTOWN METAL Will Not Dilute Opposer's Mark

The Trademark Dilution Revision Act ("TDRA") permits owners of "famous" marks to seek injunctive relief against a defendant using a mark "likely to cause dilution by blurring" of the famous mark. 15 U.S.C. § 1125(c)(1). "Dilution by blurring" is "an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). To prevail on its dilution claim, Opposer must prove (1) that it owns a famous mark that is distinctive; (2) that Applicant used a mark in commerce that is diluting of the famous mark; (3) that the similarity between Applicant's mark and Opposer's mark gives rise to an "association" between the marks; and (4) that the association is likely to impair the distinctiveness of the famous mark. *See Louis Vuitton*

Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 264-65 (4th Cir. 2007). Distinctiveness in this context refers to the “ability of the famous mark *uniquely to identify a single source* and thus maintain its selling power.” *Id.* at 265 (emphasis added).

The TDRA lists six non-exclusive factors to consider in evaluating whether there is a likelihood of dilution: (i) the degree of similarity between the alleged infringing mark and the alleged famous mark; (ii) the degree of inherent or acquired distinctiveness of the alleged famous mark; (iii) the extent to which the owner of the alleged famous mark is engaging in substantially exclusive use of the mark; (iv) the degree of recognition of the alleged famous mark; (v) whether the user of the alleged infringing mark intended to create an association with the famous mark; and (vi) any actual association between the alleged infringing mark and the alleged famous mark. 15 U.S.C. § 1125(c)(2)(B).

1. Opposer’s Mark Enjoys Only “Niche” Fame, Which Is Insufficient for Dilution

Whether or not Opposer’s mark is “famous” for dilution purposes is the threshold inquiry. *See Louis Vuitton*, 507 F.3d at 264-65. Although Opposer’s mark may be famous for music recordings, such “niche” fame *cannot* support a claim for dilution. *See Heller Inc. v. Design Within Reach, Inc.*, 2009 WL 2486054 at *4 (S.D.N.Y. 2009) (“With the 2006 amendment to federal anti-dilution law, that added the phrase ‘widely recognized by the consuming public in the United States,’ Congress intended to ‘reject dilution claims based on “niche” fame, i.e. fame limited to a particular channel of trade, segment of industry or service, or geographic region.’”) (citation omitted); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1179 (T.T.A.B. 2001); McCarthy, § 24:105 (“Fame in just one industry or line of business or only to professional buyers in one market niche is not sufficient.”) (citations omitted).

Fame for dilution purposes is difficult to prove.... In effect, an owner of a famous mark is attempting to demonstrate that *the*

English language has changed.... [T]he mark’s owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark. What was once a common noun, a surname, a simple trademark, etc., is now a term the public primarily associates with the famous mark. To achieve this level of fame and distinctiveness, the party must demonstrate that ***the mark has become the principal meaning of the word.***

Toro, 61 U.S.P.Q.2d at 1180 (citations omitted; emphasis added). Based on the irrefutable evidence that *Motown* means several different things, Opposer cannot claim that its mark “has become the principal meaning of the word.”

2. The Marks Are Not Similar Enough to Give Rise to an “Association”

For there to be an “association” between the marks sufficient for dilution, the marks must be ***essentially identical***. See McCarthy, § 24:100 and n.23 (citing *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492, 1510 (T.T.A.B. 2005), appeal dismissed, 171 Fed. Appx. 838 (Fed. Cir. 2006) (marks must be identical or very similar so that prospective purchasers see the marks as essentially the same)); § 24:119 (“without virtual identity, the injury of blurring is unlikely to occur”); *Louis Vuitton*, 507 F.3d at 268 (defendant’s mark not so similar to plaintiff’s “that it likely could be construed as actual use of the famous mark itself”); *Toro*, 61 U.S.P.Q.2d at 1183 (TORO and TORO MR not sufficiently similar for dilution); *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827 (8th Cir. 1999) (LEAN ’N TASTY not similar enough to LEAN CUISINE to create triable issue on dilution); see also 15 U.S.C. § 1125(c)(2)(B)(i).

Applicant’s mark is not similar enough to Opposer’s mark to meet the TDRA’s stringent similarity requirement. MOTOWN METAL is not essentially identical to MOTOWN such that consumers would necessarily associate one with the other. Moreover, Opposer failed to produce any evidence that consumers perceive an actual association between the marks. Opposer presents no survey evidence, although surveys are routinely used to prove association in dilution

cases. *See, e.g., Jada Toys*, 518 F.3d at 636. Nor does Opposer offer any consumer testimony regarding the marks' similarities or perceived association. *Cf. V Secret Catalogue, Inc. v. Moseley*, 558 F. Supp. 2d 734, 748 (W. D. Ky. 2008) (discussing, on remand from Supreme Court, consumer testimony on association between VICTOR'S SECRET and VICTORIA'S SECRET; finding no dilution). This is because there is no such evidence. Opposer's self-serving declarations are insufficient to show the requisite similarity needed to prove an association between the marks in consumers' minds.

3. Opposer's Mark Is Not Sufficiently Distinct for Dilution

Not only has Opposer failed to offer any proof that consumers view the marks as so identical as to give rise to an "association" between them, it failed to present any evidence of the ultimate issue for dilution—that an association between the marks is "likely to impair the distinctiveness" of the MOTOWN mark. In *Louis Vuitton*, the court confirmed that there must be *evidence* that an association is also likely to impair a mark's distinctiveness. There, the court found no triable issue on dilution despite the famousness of the mark in question and despite the defendant's *intentional* choice of a mark to create an association with the plaintiff's famous brand. 507 F.3d at 266-68. *See also V Secret Catalogue*, 558 F. Supp. 2d at 748-49 ("While it is possible that a blurring of that distinctiveness *could* occur in the minds of some consumers, we deal here with *likelihood* of blurring. We must address the evidence before us which militates against a finding of likelihood.") (emphasis original).

Not only has Opposer failed to offer evidence that a perceived association between the marks is likely to impair MOTOWN's distinctiveness, but as shown above, MOTOWN is not inherently distinct and has acquired no secondary meaning in connection with anything other than music. "A mark that evokes an association with a specific source only when used in

connection with the particular goods or services that it identifies is ordinarily not sufficiently distinctive to be protected against dilution.” Restatement 3d, Unfair Competition, § 25, comment e (1995).

4. Opposer Does Not Engage in Substantially Exclusive Use of Its Mark

As amply demonstrated by Applicant’s evidence, Opposer does not engage in substantially exclusive use of MOTOWN. Literally hundreds of other entities use the mark to convey an association with the city of Detroit or with the Motown style of music.

A mark that is merely one of several identical or very similar marks is already “diluted” in fact. In such a case, the junior user’s actions can hardly be said to be likely to cause any significant further “dilution” of such a mark. The theory of dilution by blurring is that a junior user’s mark may blur the ability of the famous senior mark to clearly identify and distinguish only one source. If there are already several sources already identified by the same mark, then “blurring” has already occurred and this new challenged use is unlikely to cause any additional, illegal blurring.

McCarthy, § 24:119. Clearly, the consuming public is able to understand that, when MOTOWN is used in conjunction with cars, automotive accessories, or toy cars, it refers to Detroit and not to Opposer. *See* Section IV.C and D *supra*; 15 U.S.C. § 1125(c)(2)(B)(iii) and (iv).

5. Applicant Did Not Intend to Create an Association with MOTOWN

In choosing MOTOWN METAL, Applicant did not intend to create any association with Opposer’s mark but rather intended to suggest an association with Detroit and its car industry. *See* Section V.C.8 *supra*. Moreover, as discussed above, Opposer’s “evidence” of Applicant’s intent to trade on the MOTOWN mark is not evidence at all but rather conjecture drawn from the fact that Applicant is aware of Opposer’s mark. *Id.*

E. A Likelihood of Confusion Will Be Avoided by Entry of the Restriction Sought in Applicant's Petition to Cancel or Limit Opposer's Registration

Partial restriction or cancellation is an equitable remedy that may be used to avoid a finding of a likelihood of confusion. *See* McCarthy, § 20:44. Despite the overwhelming evidence that there is no likelihood of confusion between the marks, if the Board is inclined to find otherwise, to the extent Opposer has or seeks registrations for MOTOWN in International Class 28, a finding of likelihood of confusion will be avoided by entry of a limitation or restriction on such registrations to preclude use in connection with toy vehicles or accessories.

In order to so restrict Opposer's registrations, Applicant need only show that (a) entry of the proposed restriction will avoid a finding of likelihood of confusion and (b) Opposer is not using its mark on those goods or services that will be excluded if the proposed restriction is entered. Lanham Act § 18, 15 U.S.C. § 1068; *see also Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 U.S.P.Q.2d 1266, 1270 (T.T.A.B. 1994); TBMP § 309.03(d). Since Opposer claims unregistered common law rights in "toys, games and playthings," a likelihood of confusion with Applicant's mark would be avoided if Opposer is not permitted to register its mark in International Class 28 for "toys, games and playthings," particularly in connection with "toy vehicles and accessories therefor." And, as shown above, Opposer has never used its mark in connection with toy vehicles and accessories therefor.

VI. CONCLUSION

Opposer has no valid grounds on which to oppose the Application for MOTOWN METAL. Opposer's MOTOWN mark is merely descriptive and has no secondary meaning outside of—arguably—recorded music. In its zeal for a monopoly on the word *Motown*, Opposer strains to assert common law rights in connection with goods that it has never sold or licensed. Applicant's use of its trademark is not likely to cause confusion with or dilute

Opposer's mark. The Opposition should be rejected. If, however, the Board is inclined to find a likelihood of confusion between the marks, such likelihood of confusion would be avoided by restricting or cancelling Opposer's mark as to toys or toy vehicles.

DATED: February 11, 2010

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Trial Brief has been personally served on counsel for Opposer UMG Recordings, Inc., both personally and through ESTTA, on February 11, 2010.

/crf/
Chad R. Fitzgerald